

REMARKS

Claims 49-67 are pending in the present application. Applicants note with appreciation the Examiner's allowance of claims 49-56 and 62-67, leaving claims 57-61 at issue in the application. In view of the amendments and remarks presented herein, reconsideration and allowance of all claims are respectfully requested.

Claims 57-61 stand rejected under 35 U.S.C. § 112, first paragraph as failing to enable one skilled in the art to make and use the invention. More specifically, the Office action argues that the recitation in claim 57 of "a fan impeller disposed on the motor shaft" is not shown in Fig. 1 or described in the specification. The Office action quotes the specification beginning at page 5 as follows:

The impeller 45 having bores to accommodate the lugs on the drive washer 40 and keyways to accommodate the second upset portion 35 is placed on the shaft,

From this, the Office action concludes that this statement supports the method of assembly claims, but not the motor assembly claims since, "The fan impeller is not disposed *on* the motor shaft." The Office action further cites page 6 of the specification, which states:

The second washer 50 also keyed to accommodate the second upset portion 35 is installed onto the shaft 15. After the drive washer 40, the impeller 45, and the second washer 50 have been installed, the motor shaft extension 55 is installed into abutment with the second washer 50.

Taking this passage from the specification in conjunction with Figure 1, the Office action reasons that:

[I]t is clear that in the final, apparatus product, the fan impeller is not disposed "on" (a reasonable interpretation of "on" being "in contact with") the motor shaft, especially since having the second washer 50 in abutment with the shaft extension would geometrically preclude such contact.

Although the quoted descriptions from the specification accurately describe one of Applicants' preferred embodiments, it is axiomatic that there is no requirement that a claim be limited to the structure of such a preferred embodiment. See Gould v. Mossinghoff, 229 U.S.P.Q. 1, 14 (D.D.C. 1985)("A broad mechanical claim, such as the claims at issue here, can be supported by disclosure of a single embodiment of the claimed invention. Such claims can be sustained even if they cover other inoperative or inadequately disclosed forms of the invention"). Furthermore, as stated in United States v. Teletronics, Inc., 8 U.S.P.Q.2d 1217,

1223 (Fed. Cir. 1988), "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." In determining whether any necessary experimentation is "undue," one factor that may be considered is the level of predictability in the art. Inventions related to the mechanical and electrical arts involve predictable factors, and therefore a single embodiment may provide broad enablement. In re Vickers, 61 U.S.P.Q. 122, 127 (CCPA 1944).

At no point does the rejection as set forth in the Office even mention the standard of "undue experimentation," let alone discuss the specific technical reasons as to why one skilled in the art could not supply any "missing" information without undue experimentation. Accordingly, a *prima facie* case of lack of enablement has not been made. In addition, one skilled in the relevant art would have at her disposal a vast body of knowledge of mechanical connections and/or methods of interconnecting an impeller to a shaft. Accordingly, to the extent any experimentation would be needed to determine how to "dispose" an impeller on a shaft, any such experimentation in view of Applicants' disclosure would not be "undue."

Despite the foregoing, and in an effort to advance prosecution of the application, Applicants have amended claim 57 to recite that the fan impeller is "mechanically coupled to" the motor shaft. Support for this claim language is found throughout the specification and drawings, including the specific portions of the specification noted above and in the Office action. Accordingly, the enablement rejection asserted against claims 57-51 should be withdrawn.

Applicants further note that claims 58, 62, and 66 are amended herein to correct obvious errors in the claims. Entry of these amendments is respectfully requested.


In view of the foregoing amendments and remarks, it is submitted that claims 49-67 as now appearing in the application are in good and proper form for allowance. A favorable action on the part of the Examiner is respectfully solicited.

If, in the opinion of the examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,  
MARSHALL, GERSTEIN & BORUN

March 21, 2003

By:

  
Brent E. Matthias, Reg. No. 41,974  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6402  
(312) 474-6300